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| 10/763,714 | 01/23/2004 | Daniel Chien | 60130-1495; 02MRA0344 | 7325 |
| 26096 | 7590 | 07/11/2006 | EXAMINER | |
| CARLSON, GASKEY & OLDS, P.C. 400 WEST MAPLE ROAD SUITE 350 BIRMINGHAM, MI 48009 | | | KRAMER, DEVON C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3683 | |

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/763,714
Filing Date: January 23, 2004
Appellant(s): CHIEN ET AL.

John Siragusa
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/31/05 appealing from the Office action
mailed 12/30/04.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-----------|----------------|---------|
| CH 663387 | Attinger | 12/1987 |
| 4583609 | Anderson et al | 04-1986 |

| | | |
|---------------------|--------------------|----------------|
| 2002/0028721 | Inoue et al | 03/2002 |
| 2003/0136613 | Seiki | 07/2003 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 4, 6, 13-14, 19-21 and 23-24 stand rejected under 35 U.S.C. 102(b) as being anticipated by Attinger (CH663387).

Claim 7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Attinger (CH663387) in view of Anderson et al (4583609).

Claims 8, 15 and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Attinger (CH663387) in view of Inoue et al (20020028721).

Claims 11-12, 18 and 22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Attinger (CH663387) in view of Seki (20030136613).

(10) Response to Argument

IN reference to appellant's arguments with respect to claims 1, 4 and 6, Attinger provides an axle shaft (3, 7, 9) mounted for rotation within a housing (5) and a rotor (11) disposed outside the housing and attached to the axle shaft. Please note that portions of the axle shaft (7, 9) extend inside the housing (5). Please note there are two ways to read Attinger regarding claim 1. Scenario 1, is Attinger provides an axle assembly having an axle shaft (3, 7, 9), the axle shaft having a first end (element 2 in the figure) and a second end (near element 7), the axle mounted for rotation within a housing (5), the first end and the second end extending outside of the housing; a hub (2) fixed to the

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first end of the axle shaft; and a brake assembly including a rotor (11) disposed outside of the housing and attached to the axle shaft adjacent the second end, wherein the second end is spaced apart from the hub a first length greater than an axial length of the housing. Further in scenario 2, Attinger can be read as follows: Attinger provides an axle assembly having an axle shaft (3, 7), the axle shaft having a first end (near hub portion on the left side of the figure) and a second end (near housing 5), the axle mounted for rotation within a housing (5), the first end and the second end extending outside of the housing; a hub (2) fixed to the first end of the axle shaft; and a brake assembly including a rotor (11) disposed outside of the housing and attached to the axle shaft adjacent the second end, wherein the second end is spaced apart from the hub a first length greater than an axial length of the housing. Please note the difference between the two readings is that in one the axle shaft is considered the portion of the axle to left of the housing (5) and in the other reading the axle shaft is considered the entire axle. Appellant argues that it is clear what is meant by "the second end". Please note that the first end can be the right portion of the axle and the second end can be the second end of the axle in the first scenario and, in the second scenario, the first end can be the portion attaching the left wheel in the figure and the second end can be the portion near the housing. Please note that both of these reading meet the claim limitations.

In reference to appellants arguments with respect to claims 13-14, 19-21, 23 and 24, appellant bring forth the same arguments as in claim 1. Please refer to the above rebuttal.

In response to appellant's argument with respect to claim 7, that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Please note that both pneumatically operated and hydraulically operated brakes are well known throughout the art. Equipping a vehicle with either pneumatic or hydraulic brakes is a design choice.

In re claims 8, 15 and 17, appellant argues that there is no suggestion to combine the references. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is well known in the art that shafts are supported by bearings.

In re appellant's arguments with respect to claims 11-12, 18 and 22 are for the most part moot because claim 1, 13 and 19 remain rejected. Further appellant argues that that there is no suggestion to combine the references. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of

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the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). It is well known in the brake art to mount the brake to a portion of a suspension because the suspension is disposed near the wheels and axles and are rigid sturdy members.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Devon Kramer


6/29/06

Conferees:

Jim McClellan 

Rob Siconolfi 